Atty. Dkt. No. 028622-0103

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**



Applicant: Ernst Peter RIEBER

Title: ANTIBODIES TO DENDRITIC CELLS AND HUMAN DENDRITIC CELL POPULATIONS AND USES THEREOF

Appl. No.: 09/700,200

Filing Date: 01/23/2001

Examiner: Gerald R. Ewoldt

Art Unit: 1644

## RESPONSE TO SECOND RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the second restriction requirement set forth in the Office Action mailed March 17, 2003, A request for a five-month extension of time is attached with requisite fee to extend the time to respond to September 17, 2003. If such a request and/or fee are missing, please consider this paragraph a request for the extension of time and authorization to withdraw the appropriate fee from Deposit Account No. 19-0741.

Applicant hereby provisionally elects species A, the antibody produced by the hybridoma DSM ACC2241, for examination, with traverse.

The Examiner originally made a **20 way** restriction for which applicant elected Claims 1-6, 8-11, 16, 17 and 46 (Group I) with traverse. The Examiner has revised this original restriction by stating that claim 46 was inadvertently included in Group 1 and joined Group II directed to claims 1-7 and 46, the latter of which applicant kindly thanks the Examiner. Thus, it now appears that the Examiner will examine claims 1-6, 8-11, 16 and 17 as directed to the species of an antibody produced by the hybridoma DSM ACC2241,

But the Examiner is again reminded that pursuant to MPEP § 1850, in PCT national phase cases, (§371 cases) the Examiner is required to follow the determination of the International Bureau and cannot *sua sponte*, set forth his or her own groupings for purposes of examination. For example, *Caterpillar Tractor Co. v Commissioner of Patents*, 650 F.Supp. 218, 231 USPQ 590 (VA 1986).

The standards of restriction practice for PCT applications entering the national stage in the United States Patent & Trademark Office, as is the present application, are governed by 37 CFR §§ 1.475 and 1.499. The present application contains claims to all three categories of product, process of making and process of use, and pursuant to 37 CFR § 1.475 (b), an international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:...(3) A product, a process specially adapted for the manufacture of the said product, and **a use of the said product**;..." This category applies to the present application, and in view of this patent rule, it is requested that claim 30 (Group VII) directed to a method of isolating or identifying DCs using the elected antibody be included with the claims of Groups I and II, and examined on the merits.

Again applicant requests reconsideration of the kit claim (41), composition claims (42 and 43) and diagnostic composition claim (45), all of Group XIII, to the extent that it comprises the antibody of Group I or Group II.

In regard to the election of species, the Examiner has indicated that all claims are generic. Accordingly, applicant requests full examination of the generic claims once the elected species is found allowable.

Reconsideration of the restriction requirement is therefore respectfully requested as indicated above. Applicants, of course, reserve the right to file one or more divisional applications covering the subject matter of the non-elected claims and species. Examination on the merits is kindly requested.

Respectfully submitted,

Date September 12, 2003

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